

TAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD



SPATIAL TECHNOLOGY, INC.,	)	07-22-2002
	)	U.S. Patent & TMO/TM Mail Rpt Dt. #70
Opposer,	)	Opposition No. 118,447
v.	)	Serial No. 75/732,112
OBJECTFX CORPORATION	)	Mark: SPATIALFX
Applicant.	)	Docket No. 195.019USA

**RESPONSE TO ORDER TO SHOW CAUSE**

In response to the Order to Show Cause, applicant encloses herewith a Settlement Agreement signed by the Opposer

TRADEMARK TRIAL AND  
APPEAL BOARD  
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Applicant's attorney expects that applicant will sign the Agreement shortly to resolve all of the issues in the above-referenced opposition.

Applicant apologizes for failing to keep the Board apprised of the progress of the extended settlement negotiations in this matter. Applicant fully expected to be able to complete the Settlement Agreement several months ago.

Applicant expects to send the fully executed Settlement Agreement and a Request for Withdrawal of the Opposition with Prejudice, in the next two weeks.

Opposition No.: 118,447

Page Two

Respectfully submitted,

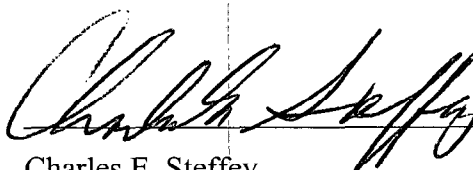
SCHWEGMAN, LUNDBERG, WOESSNER &  
KLUTH, P.A.

Attorneys for Applicant

ObjectFX Corporation

Date:

July 17, 2002



Charles E. Steffey

P.O. Box 2938

Minneapolis, MN 55402

(612) 373-6970

**"Certificate of First Class Mail" - 37 CFR 1.8**

**Date of Deposit: July 17, 2002**

I hereby certify that this paper or fee is being deposited with the United States Postal Service "First Class Mail to Addressee" service under 37 CFR 1.8 on the date indicated above and is addressed to BOX TTAB NO FEE Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Kim Nute

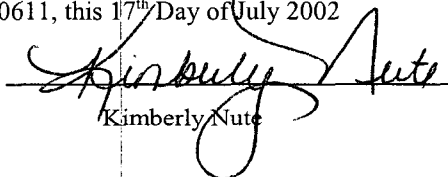
Printed Name



Signature

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing RESPONSE TO ORDER TO SHOW CAUSE was served upon Opposer's attorneys of record by transmitting a copy of same to the attention of Eric H. Weimers, Esq., Fax No. (312) 840-7350, identified as the law firm of Jenner & Block, and by depositing a copy of same with the U.S. Postal Service, as first class mail, postage prepaid, in an envelope addressed to: Eric H. Weimers, Esq. Jenner & Block, One IBM Plaza, Chicago, IL 60611, this 17<sup>th</sup> Day of July 2002



Kimberly Nute

## **AGREEMENT**

**THIS AGREEMENT**, made this \_\_\_ day of \_\_\_\_\_, 2002, by and between ObjectFX Corporation, 2515 Wabash Avenue, Suite 200, St. Paul, Minnesota 55114 (hereinafter, "ObjectFX") and Spatial Corp., 10955 Westmoor Drive, Suite 425, Westminster, Colorado 80021, as successor-in-interest to Spatial Technology Inc.'s rights in the names and marks SPATIAL and SPATIAL TECHNOLOGY, (hereinafter, "Spatial");

**WHEREAS**, ObjectFX is using and owns United States Trademark Registration 1,997,389 for the mark SPATIALWORKS.

**WHEREAS**, ObjectFX is using and has applied for registration in the United states for the marks SPATIALX, Serial No. 75/731,645 and SPATIALFX, Serial No. 75/732,112, and has registrations and applications for other marks using the term "Spatial", in the United States and foreign countries.

**WHEREAS**, Spatial owns United States Trademark Registrations Nos. 2,526,208 and 2,548,540 for the marks SPATIAL TECHNOLOGY (Stylized);

**WHEREAS**, Spatial initiated Trademark Oppositions Nos. 118,413 and 118,447 in the United States Patent and Trademark Office against the SPATIALX and SPATIALFX marks;

**WHEREAS**, the parties have agreed to resolve the pending oppositions and any other dispute they may have regarding their respective uses of the mark SPATIAL, SPATIALWORKS, SPATIALX and SPATIALFX pursuant to the terms and conditions of this Agreement.

**NOW, THEREFORE**, in consideration of the mutual promises exchanged herein and other good and valuable consideration, it is hereby agreed as follows:

1. **Intent and Purpose.** It is the intention and purpose of this Settlement Agreement to

enable the parties to effect a full and final settlement of any and all disputes between them with regard to the marks SPATIAL, SPATIALX and SPATIALFX. However, the parties understand and agree that in the event either party incurs any necessary additional expense, including reasonable attorney's fees in enforcing this Agreement due to a material breach by the other party, that the breaching party will pay for and be responsible for the other party's expenses and reasonable attorney's fees.

2. **Cooperation.** All Parties to this Agreement will take all necessary steps and exercise their best efforts to consummate this Agreement.

3. **Approval.** The Parties represent and warrant that all requisite corporate action to approve this settlement has been taken, and upon due execution by all parties, this Agreement shall be a valid and binding obligation on the corporations. The representatives of the respective Parties are authorized as counsel, and where necessary, as agents, to take all steps on behalf of their respective clients which this Agreement contemplates.

4. **Terms.**

a. **Provisions relating to use by ObjectFX of the marks SPATIALWORKS, SPATIALX, SPATIALFX and other Spatial marks.**

Object FX may use the SPATIALX and SPATIALFX marks for computer software; namely software for the development, deployment and utilization of applications which provide for the management, retrieval, analysis, presentation and visualization of information through graphic and textual representations of data, for use on personal computers and other personal computing devices, network servers and clients, web servers and web browsers and navigation devices.

ObjectFX may use the mark SPATIALWORKS for object-oriented software for the

management, retrieval, analysis and visualization of geographic and spatial data; data management software for organizing information in the fields of transportation, telecommunications, economics, computer networking, meteorology, finance, engineering, graphic design, statistics, photography, seismic activity, geometry, computer-aided design (CAD), full motion video, agriculture, architecture, medicine and logistics into maps, tables, forms and images.

ObjectFX may use other trademarks and service marks containing the term "spatial" to identify software products or services that display data and information graphically, visually or textually for demographics, geographic mapping, supply chain management, transportation and logistics, communications and asset management.

ObjectFX will not use any other trademark or service mark containing the term "spatial" to identify software products or services that (1) perform the function of 3D modeling in Computer Aided Design (CAD), Computer Aided Manufacturing (CAM), Computer Aided Engineering (CAE) and/or 3D Product Lifecycle Management (3D PLM) applications or (2) permit users to create, access, modify, translate, transmit or share 3D models in CAD, CAM, CAE or 3D PLM applications.

ObjectFX also agrees that it will not use the term "spatial" as part of its corporate name or trade name. The before specified limitations shall not be construed to in any way limit ObjectFX from offering its software over the Internet, or as part of any web-based software application or solution.

b. **Provisions relating to use by Spatial of Spatial marks.**

Spatial may specifically use trademarks and service marks containing the term "spatial"

to identify software products or services that (1) perform the function of 3D modeling in CAD, CAM, CAE and/or 3D PLM applications or (2) permit users to create, access, modify, translate, transmit or share 3D models in CAD, CAM, CAE or 3D PLM applications.

Spatial will not use any trademark containing the term "spatial" to identify software products sold by Spatial that display data and information graphically for demographics, geographic mapping, supply chain management, transportation and logistics, communications, and asset management. The foregoing provision shall not be deemed to prevent Spatial from selling any products on an OEM basis for incorporation in third-party products and systems for use in any of the aforesaid applications.

Provided the before specified limitations with regard to trademark use are complied with, there are no other limitations with regard to Spatial's use of the term "spatial" as a business entity identifier, trade name or corporate name in connection with any of its products or services.

The before specified limitations shall not be construed to in any way limit Spatial from offering its software over the Internet, or as part of any web-based software application or solution.

c. **Withdrawal of Oppositions.** Spatial will withdraw, with prejudice, Oppositions Nos. 118,413 and 118,447 which it filed in the TTAB against Object FX's applications to register SPATIALX and SPATIALFX, respectively.

d. **Material Breach.** Each party understands and agrees that any breach of a party's obligations as specified in this Section 4, will be a material breach of this Agreement.

5. **Release.** Upon the condition that each party complies with the terms and conditions of this Agreement, including in particular the terms and conditions specified in

Sections 4 of this Agreement, each party hereby releases, acquits and forever discharges the other party from and against all claims, demands, rights, and causes of action which that party has had or now has against the other party for trademark infringement or unfair competition with regard to use of any of the marks SPATIALWORKS, SPATIALX and SPATIALFX.

6. **Parties Bound.** This Agreement shall apply to the Parties and to the extent provided for in this Agreement, their respective agents, representatives, employees, attorneys, successors, assigns and any business entity that has been, is or will be controlled by one or more of the Parties and/or any officers of the Parties.

7. **Governing Law and Venue.** This Agreement shall be construed and enforced in accordance with the laws of the State of Minnesota, any dispute under this Agreement will be venued in either a State or Federal Court located in the State of Minnesota.

8. **Execution of Counterparts.** This instrument shall be executed in two (2) or more identical counterparts by the respective Parties, each of which, for all purposes, shall be deemed to be an original and all of which shall constitute, collectively, this Agreement. When making proof of this instrument it shall not be necessary to produce or account for more than one counterpart.

9. **Representations.** Each Party represents to the other party, that party has full authority and authorization to enter into this Agreement, and to fully bind that party to this Agreement.

10. **Acknowledgment.** Each Party hereby expressly acknowledges that they: (1) have had adequate time to review this Agreement with legal counsel of their own choosing; (2) fully understand the terms and conditions contained herein; and (3) have entered into this

Agreement of their own free will and were not under any undue pressure or duress.

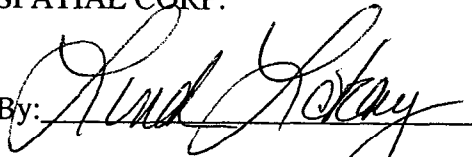
11. Entire Agreement. This Agreement represents the entire understanding and agreement between the parties with regard to the Subject matter hereto, and may not be amended except in a writing executed by a duly authorized representative of the party against whom the amendment is to be charged.

Agreed:

SPATIAL CORP.

OBJECT FX CORPORATION

By:



By: \_\_\_\_\_

Title:

VP, SALES & MARKETING

Title: \_\_\_\_\_

Date:

6-28-02

Date: \_\_\_\_\_